



Application No. 09/485,903  
Attorney Docket No. 05725.0532-00

## REMARKS

### STATUS OF CLAIMS

Claims 18-26, 28-36, and 40-48 currently are pending. No claim amendments are made by this reply.

### II. REJECTION UNDER 35 U.S.C. § 103

The Office continues to reject claims 18-26, 28-36, and 40-48 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,721,026 to Feder et al. ("Feder") in view of both U.S. Patent No. 6,024,946 to Dubief et al. ("Dubief") and EP 0 240 349 to Bolich ("Bolich"). Office Action at page 3. The Office maintains that Feder teaches  $\alpha,\omega$ -disilanol dispersions and insoluble organic (co)polymer particles useful as cosmetic compositions for the treatment of hair, especially for achieving permanent waving. *Id.* Admittedly, Feder is deficient in that it fails to disclose the amount of  $\alpha,\omega$ -disilanol and the manner to dispense the composition. *Id.* The Office, however, contends that it would have been obvious to a skilled artisan to look to other references in the art to remedy these deficiencies. According to the Office, Dubief and Bolich remedy these deficiencies by teaching the use of silicone in the amounts claimed (Dubief) and the use of the claimed propellants in mousses in the amount claimed (Bolich). *Id.* at page 4-6. Applicants continue to respectfully disagree with the Office for the reasons of record and the additional reasons below.

In particular, the Office contends a motivation exists to employ the weight percent of silicone from Dubief into the invention of Feder because "(1) Dubief et al. teaches ranges of silicone and polymer particle weight percentages that either encompass or overlap with the percentages of the claims of the instant invention, and (2) it has been

held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” Office Action at page 5 (citing *In re Aller*, 105 U.S.P.Q. 233 (C.C.P.A. 1955)). This rationale is improper on at least two different levels: first, the Office improperly uses Applicants’ teachings as a source of motivation and second, the Office disregards the factual differences between the references.

First, the Office concludes that a motivation to combine Feder and Dubief exists because “(1) Dubief et al. teaches ranges of silicone and polymer particle weight percentages that either *encompass or overlap with the percentages of the claims of the instant invention . . .*” Office Action at page 5 (emphasis added). “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Roufett*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). Here, the Office clearly ignores all three sources and instead, looks to Applicants’ invention.

The Federal Circuit clearly admonishes such a practice, as it goes against the process to determine patentability. *Id.* at 1357, 47 U.S.P.Q. at 1457. To require that the Office show a motivation to combine, this “stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.” *Id.* at 1358, 47 U.S.P.Q.2d at 1458. The Office tramples this safeguard here by relying on Applicants’ teachings as a motivation for the combination.

Second, the Office claims an additional motivation for combining Feder and Dubief because “it has been held that where the general conditions of a claim are

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” Office Action at page 5. The Office even cites *In re Aller* to support its claim. *Aller*, however, does not address the circumstances where the elements of the claims and of the references are different, as in the present case.

The present claims include, *inter alia*, “an emulsion comprising at least one non-aminated silicone  $\alpha,\omega$ -disilanol.” Feder discloses an  $\alpha,\omega$  (dihydroxy) polydiorganosiloxane emulsion but as admitted by the Office, fails to provide a percent of weight of non-aminated  $\alpha,\omega$ -disilanol as ranging from 0.05% to 10% by weight. Office Action at page 3. Instead, the Office relies on Dubief’s teaching of at least one silicone. Dubief, however, does not disclose any siloxane in the form of an emulsion. In fact, Dubief states that silicones “may be in the form of oils, waxes, gums or resins.” Dubief at Col. 2, line 11. As such, Dubief fails to disclose or suggest that its silioxanes are in an emulsion. Without such a teaching, how can one import the weight percentage when the subject matter of the two references is different?

Thus, at best, it might be obvious to try to modify Feder with the teachings of Dubief, since Dubief discloses siloxanes and different forms other than dispersions. The Office, however, cannot base a determination of obviousness on what the skilled person might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do; this the Office has not shown. See *In re O’Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). The rejection is improper for at least these reasons.

Moreover, Feder teaches that “the emulsion (A) prepared by emulsion polymerization or by emulsifying the silicone polymer is in the form of an oil-in-water

emulsion and preferably has a solids content of at least 40% by weight.” Feder at Col. 5, ll. 13-16. This suggests that the solids content is a central factor for Feder’s silicone emulsions. But despite this teaching, the Office imports for combination a teaching directed to anything but an emulsion. This is further evidence against such a combination and the type of improper hindsight reconstruction used by the Office to arrive at the present invention.

Applicants also note that the Office asserts that “[a]ny properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art,” and that the burden is on “Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product.” Office Action at page 6. Applicants disagree with the Office. The Office’s reliance on inherency to support an obviousness rejection is improper because unlike a Section 102 rejection, where each and every element must be found in a single prior art reference, the Office is able to use a combination of references to demonstrate the missing element. But for the sake of the argument, to support an assertion of inherency, the Office must prove factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *See Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Int. 1990). In the present case, however, all the Office has done is merely assert that the prior art teaches the same components as instantly claimed, which hardly counts as a factual and technical ground for establishing inherency. Moreover, as discussed above, the Office has yet to provide a motivation for the combination of references. *See M.P.E.P. § 2143.*

For at least these reasons, Applicants respectfully request the withdrawal of the rejection.

### III. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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